

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	YOUNGER AHLUWALIA	Art Unit: 1794
Serial No.:	10/766,652	Examiner: Ula C. Ruddock
Filed:	January 27, 2004	Confirmation No.: 3967
Title:	COMPOSITE MATERIAL	May 12, 2009

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL FILING

The Related Proceedings Appendix section of the brief filed Monday, May 11, 2009, references the Board's decision in U.S. Patent Application No. 10/354,220. In accordance with MPEP § 1205.02, please find a copy of that decision attached herewith.

No fee is believed to be due in connection with the filing of this Supplemental Submission. Nonetheless, the Commissioner is hereby authorized to charge any such fee determined to be due, and credit any overpayment, to Deposit Account No. 06-1205.

Applicants' undersigned attorneys may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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FCHS_WS 3322870_1

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOUNGER AHLUWALIA

Appeal 2007-3294
Application 10/354,220
Technology Center 1700

Decided: August 28, 2007

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 2 through 11 in the Office Action mailed October 25, 2005. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

ORDER REMANDING TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The Examiner changed the statutory basis of the ground of rejection of claims 2 through 11 as anticipated by United States Patent 5,965,257 to Ahluwalia, issued October 12, 1999, from 35 U.S.C. § 102(e) to 35 U.S.C. § 102(b) in the Answer in response to Appellant's contention in the Brief that the former statutory provision was inappropriate "because the Appellant is the inventor of the Ahluwalia reference, and the instant application and the cited Ahluwalia reference are commonly owned" (Answer 2-3 and 3-4; Br. 8-9 and n. 1, citing 35 U.S.C. § 102(e)(2)). In entering this new ground of rejection in the Answer, the Examiner denied benefit of priority for appealed claims 2 through 11 to parent Application 09/663,225 (parent Application), filed September 15, 2000, under 35 U.S.C. § 120 on the basis the parent Application does not "provide support or enablement" under 35 U.S.C. § 112, first paragraph, "for one or more claims of this application" because "no surfactant or microcells are discussed in the prior filed application" (Answer 2-3). Independent claim 2, on which all other claims directly or ultimately depend, encompasses a fire resistant fabric material comprising at least a substrate coated with a structural material comprising, among other things, a prefabricated microcell component, a surfactant component, and surfactant-generated microcells.

Appellant contends the parent Application, which matured into U.S. Patent 6,586,353, claims benefit of Provisional Application 60/168,057 (Provisional Application), filed November 30, 1999, with each of these Applications incorporating by reference "the text of the cited Ahluwalia reference" (Reply Br. 4, citing Provisional Application 60/168,057, 3:9-10, and U.S. Patent 6,586,353, col. 2, ll. 57-59; *see also* Br. 9 n.1). Appellant contends the parent and Provisional Applications properly incorporate "essential material" from the Ahluwalia reference pursuant to 37 C.F.R. § 1.57(c), and that if the Ahluwalia reference does anticipate claims 2 through 11, the reference "would necessarily provide adequate support and enablement for claims 2-11" under § 112, first paragraph, entitling the claims to the benefit of the parent and provisional Applications, and thus, avoiding the ground of rejection under § 102(b) (Reply Br. 4-5).

The Examiner did not respond to the issues raised by Appellant with respect to the new ground, stating only "[t]he reply brief filed January 22, 2007, has been noted" in the Office Action mailed May 16, 2007. *See* 37 C.F.R. § 41.43(a)(1) (2006).

The issues raised by Appellant's contention involve whether the incorporation-by-reference of the Ahluwalia reference in the parent Application and the Provisional Application is sufficient to provide "essential material" satisfying the requirements of § 112, first paragraph, with respect to the invention encompassed by claims 2 through 11, establishing that Appellant is entitled to the benefit of the dates of these Applications under § 120 with respect thereto, and thus removing the ground of rejection of the claims under § 102(b) over the reference. *See*

37 C.F.R. § 1.57(c) (2006); MPEP §§ 608.01(p), I. Incorporation by Reference, and 2163.07(b) (8th ed., Rev. 5, August 2006). The Examiner has not considered the issues. Accordingly, the issues in this appeal have been incompletely prosecuted and briefed, and thus, the record is incomplete for purposes of appeal.

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to consider the issues with respect to incorporation-by-reference of "essential material" from the Ahluwalia reference in the parent Application and the Provisional Application, and the applicability of the ground of rejection under 35 U.S.C. § 102(b) over the Ahluwalia reference as set forth above, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This Remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 C.F.R. § 41.50(a)(2) (2007), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

Appeal 2007-3294
Application 10/354,220

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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